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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,376	08/02/2001	Masahiko Sato	450100-03439	4275
20999	7590	08/23/2005	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			SCHUBERT, KEVIN R	
			ART UNIT	PAPER NUMBER
			2137	
DATE MAILED: 08/23/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,376

Applicant(s)

SATO ET AL.

Examiner

Kevin Schubert

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-15, and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

Claims 1-7,9-15, and 17 have been considered. Regarding claims 3,6,11, and 14, the examiner notes that the best art possible was applied to the claims given the logical inconsistent between the dependent claim limitations and the independent claims on which they depend.

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***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/29/05 has been entered.

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***Claim Objections***

Claims 1-2,4-5,7,9-10,12-15, and 17 are objected to because of the following informalities: in independent claims 1,9, and 17, the applicant refers to "said portable radio device" when portable radio devices (plural) has been introduced. The examiner notes that this discrepancy is present throughout the dependent claims as well. Appropriate correction is required.

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 3,6,11, and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claims 3 and 11, the claims disclose that

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the transmission output is **only** reduced in a particular one of said radio devices. Independent claims 1 and 9 have been amended to disclose that the coverage area of **both** portable devices is reduced. Thus claims 3 and 11 are logically inconsistent with amended claims 1 and 9. Claims 6 and 14 are rejected based on similar reasoning.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-7,9-15, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1,9, and 17, recite the limitation "preventing communication with an unintentional portable radio device by narrowing the coverage area of both portable devices to be mutually authenticated before authentication initiates". It is unclear whether the phrase "before authentication initiates" refers to narrowing the coverage area or the mutual authentication.

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### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

20 rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-7,9-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cotton, U.S. Patent No. 6,148,205, in view of Nealon, U.S. Patent No. 5,463,659, in further view of Executive Council (Executive Council. Fourteenth Session. 2-5 February 1999. pages 1,22).

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As per claims 1,9, and 17, the applicant describes an authenticating method for portable radio devices, comprising data communicating means for performing radio communication over a first coverage area and authorizing means for performing authentication of said portable radio device over a second coverage area, comprising the following limitations which are met by Cotton, Nealon, and Executive

5 Council:

a) switching coverage area of two or more of said portable radio devices to be mutually authenticated from the first coverage area to the second coverage area, the second coverage area being smaller than the first coverage area (Cotton: Col 2, lines 28-40; Executive Council: page 22);

10 b) the two or more portable radio devices to be mutually authenticated having the second coverage area being brought with in proximity to one another so that the coverage areas overlap (Cotton: Col 2, lines 28-40);

c) performing mutual authentication between two or more portable radio devices by said authenticating means automatically or after confirmation by users of said portable radio devices (Cotton: lines 28-40);

15 d) preventing communication with an unintentional portable radio device by narrowing the coverage area of both portable radio devices to be mutually authenticated before authentication initiates (Nealon: Col 8, lines 23-34);

Cotton discloses that the coverage area of two radio devices which are mutually authenticated is narrowed in order to prevent communication with an unintentional device (Col 2, lines 37-40). However,  
20 Cotton does not specifically disclose that the coverage area is switched *before* authentication initiates. Nealon discloses a similar authentication procedure which takes place between two radio devices. Nealon also discloses narrowing the coverage area of the two radio devices before any authentication data is exchanged in the authentication procedure. This is done by the user pressing a button in order to put the two radio devices in a second coverage area operating at a lower than normal power level. Once  
25 the two radio devices are in the second coverage area state, the user can then initiate the authentication procedure by sending authentication data to the base station (Col 9, lines 3-33).

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Combining the ideas of Nealon with those of Cotton allows the two radio devices to switch to the second coverage area before any authentication data is exchanged. This could be accomplished in the same manner as Nealon describes by simply pressing a button to switch to the second coverage area before authentication data is exchanged. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Nealon with those of Cotton because switching to the second coverage area before authentication data is exchanged makes the system more robust because it prevents erroneous communication with an unintentional device during the authentication procedure.

Cotton in view of Nealon disclose communication between a portable device and a base station. Both Cotton and Nealon are silent as to whether the base station is portable. Executive Council discloses the idea that a radio base station may be portable. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Executive Council with those of Cotton in view of Nealon because having a portable base station allows the base station to be more versatile as it can be moved around the room to provide the most efficient communication between itself and the portable device(s).

As per claims 2 and 10, the applicant describes the authenticating method for portable radio devices according to claims 1 and 9, which are met by Cotton in view of Nealon in further view of Executive Council, with the following limitation which is met by Cotton:

Wherein the step of performing the authentication by said authenticating means is performed in a state where a transmission output of said portable radio device is reduced to shorten a communication distance of said portable radio device (Cotton: Col 3, lines 20-27).

As per claims 3 and 11, the applicant describes the authenticating method of claims 2 and 10, which are met by Cotton in view of Nealon in further view of Executive Council, with the following limitation which is met by Cotton:

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Wherein the transmission output is reduced only in a particular one of said portable radio devices (Fig 4).

As per claims 4 and 12, the applicant describes the authenticating method of claims 2 and 10,  
5 which are met by Cotton in view of Nealon in further view of Executive Council, with the following limitation which is met by Cotton:

Wherein the transmission output is reduced upon turning-on of an authentication button provided on said portable radio device (Cotton: Col 3, lines 53-56).

10 As per claims 5 and 13, the applicant describes the authenticating method of claims 1 and 9, which are met by Cotton in view of Nealon in further view of Executive Council, with the following limitation which is met by Nealon:

Wherein the step of performing the authentication by said authenticating means is performed in a state where reception sensitivity of said radio device is reduced to shorten a communication distance of  
15 said radio device (Nealon: Col 8, lines 23-34).

As per claims 6 and 14, the applicant describes the authenticating method of claims 5 and 13, which are met by Cotton in view of Nealon in further view of Executive Council, with the following limitation which is met by Nealon:

20 Wherein the reception sensitivity is reduced only in a particular one of said portable radio devices (Nealon: Col 8, lines 23-34).

As per claims 7 and 15, the applicant describes the authenticating method of claims 5 and 13, which are met by Cotton in view of Nealon in further view of Executive Council, with the following  
25 limitation which is met by Cotton:

Wherein the reception sensitivity is reduced upon turning-on of an authentication button provided on said portable radio device (Cotton: Col 3, lines 53-56).

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***Response to Arguments***

Applicant's arguments with respect to claims 1-7,9-15, and 17 have been considered but are moot in view of the new ground(s) of rejection.

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***Conclusion***

This action is made non-final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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KS

  
EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER

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